

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* NOBUHIKO OTA, TOSHIKAZU HAMAO  
and YOSHIFUSA TSUBONE

---

Appeal 2006-1736  
Application 10/471,180  
Technology Center 1700

---

Decided: September 29, 2006

---

Before KIMLIN, PAK, and KRATZ, *Administrative Patent Judges*.  
KRATZ, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the Examiner for further consideration and explanation of issues raised by the record. 37 C.F.R. § 41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 3, August 2005).

A review of the Briefs and Answer reveals that an initial threshold issue raised in this appeal relates to the availability of Gabrys (U.S. Patent No. 6,798,092) as prior art to Appellants' claimed subject matter. According to United States Patent and Trademark Office (USPTO) records, the Gabrys' patent issued from U.S. Application No. 09/976,506, filed on October 12, 2001. Gabrys included a reference to earlier filed provisional application No. 60/241,575, filed on October 12, 2000.

Appellants submitted national stage application papers for this application on November 09, 2003 based on an earlier filed International Application No. PCT/JP02/0216 on March 07, 2002 and claimed a foreign priority benefit under 35 U.S.C. § 119(a) to an earlier filed application in Japan (JP 2001-70899 filed on March 31, 2001).

Faced with several rejections relying on Gabrys as applied prior art, among other applied evidence, Appellants submitted a verified English language translation of JP 2001-70899 on April 14, 2005 asserting that the filing date (October 12, 2001) of the non-provisional application from which Gabrys issued is a date subsequent to the filing date (March 31, 2001 of the foreign priority date claimed by Applicants pursuant to 35 U.S.C. § 119(a), based on the Japanese filing. However, Appellants' assertion was not substantiated with a showing that the priority application is for the same invention; that is, Appellants have not shown where each and every rejected claim of this application is fully supported in the manner required by 35 U.S.C. § 112, first paragraph in the earlier filed foreign priority application for which priority benefit is claimed.

Nor has the Examiner furnished a detailed analysis substantiating that each of Appellants' rejected claims are fully supported in the earlier filed § 119(a) benefit application.

Consequently, we remand this application to the Examiner to cause a further development of the written record of this application as to this foreign priority benefit issue. The development on this record of the foreign priority issue is only a first step here because, as both Appellants and the Examiner have recognized, the resolution of that matter does not resolve the issue of the availability of Gabrys as § 102(e) prior art to the here claimed subject matter. This is so because of an earlier filed provisional application benefit referred to in Gabrys.

If the Examiner determines that the § 119(a) benefit claimed by Appellants is substantiated on the written record or if Appellants are known to be in disagreement with the Examiner's contrary determination concerning this matter, the Examiner should revisit the related earlier filed provisional application referred to in the Gabrys' patent, which provisional application was assigned an earlier filing date than Appellants' claimed earliest foreign priority date. The Examiner should further explain how and where that provisional application supports, in the manner provided by § 112, first paragraph the subject matter of the relied upon Gabrys' patent invention such that a § 102(e) date based on that earlier provisional application filing may be accorded the Gabrys' patented subject matter relied upon by the Examiner in rejecting the claims. *See* 35 U.S.C. § 119(e)(1).

In this regard, in order to rely on a document as prior art with respect to the appealed claims under 35 U.S.C. §§ 102(e) and 103(a), the Examiner must establish that the document is in fact applicable as prior art to the claims.

In this regard, we are cognizant that the Examiner referred to page 3, lines 40-45, page 4, lines 34-43 and other sections of the provisional application referenced in Gabrys in the Answer. However, the Examiner has not fully explained how those portions of the provisional application furnish § 112, first paragraph support for at least the inventive teachings that the Examiner relies upon in rejecting the appealed claims, which are disclosed in the Gabrys' patent. *See In re Wertheim* 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981) ("[T]he determinative question here is whether the invention claimed in the Pflunger patent finds a *supporting disclosure in compliance with § 112*, as required by § 120, in the 1961 Pflunger I application so as to entitle that invention in the Pflunger patent, as "prior art," to the filing date of Pflunger I. Without such support, the invention, and its accompanying disclosure, cannot be regarded as prior art as of that filing date."). In responding to this Remand, the Examiner should review *Wertheim* respecting the determination of a § 120/§ 102(e) prior art date therein and consider how the court's reasoning set forth in that decision may or may not analogously apply to the present § 102(e) /§ 119(e) prior art date sought to be accorded the applied patent by the Examiner. Also, *see* MPEP § 706.02, subsection V. (D), and § 706.02(f)(1), subsection II., Example 2 (8th ed., Rev. 3, August 2005).

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to address the

matter discussed above, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This Remand is made for the purpose of directing the Examiner to further consider the ground of rejection advanced on appeal. Accordingly, if the Examiner submits a Supplemental Answer to the Board in response to this Remand, “appellant must within two months from the date of the supplemental examiner’s answer exercise one of” the two options set forth in 37 C.F.R. § 41.50(a)(2) (2005), “in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding,” as provided in this rule.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

**REMANDED**

sld

SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, NW  
WASHINGTON, DC 20037